

**REMARKS**

Applicants have carefully reviewed this Application in light of the Office Action mailed February 14, 2006, the Advisory Action mailed May 22, 2006, and the Notice of Panel Decision from Pre-Appeal Brief Review mailed August 23, 2006. Claims 1, 3-6, 9-47, 49-52 and 55-101 are pending in this Application. Claims 1, 3-6, 9-47, 49-52 and 55-101 stand rejected under 35 U.S.C. § 103(a). Applicants have amended Claims 1, 33, 47, 79 and 93 to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

**Rejections under 35 U.S.C. § 103**

Claims 1, 33, 47, 79 and 93 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,564,261 issued to Gudjon M. Gudjonsson et al. ("*Gudjonsson*") in view of U.S. Patent No. 5,758,280 issued to Misa Kimura ("*Kimura*").

Claims 1, 3-6, 9-47, 49-52 and 55-101 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,430,602 issued to Timothy Kay et al. ("*Kay*") in view of *Gudjonsson* and further in view of *Kimura*.

*Gudjonsson* discloses a system and method of establishing communication sessions between users as a function of their availability and/or communication devices. Users registered with a cluster containing user servers (US) 19 establish a communication session by using devices (see Table 5, Col. 33). The communication session may be established when a first user sends an invitation message to a second user regarding establishment of the communication session. (Col. 24, Lines 32-42). A user server 19 associated with the first user determines how to route the invitation message to the second user. (Col. 24, Lines 47-55). The invitation is received by a user server 19 associated with the second user and the second user's user server 19 forwards the invitation message to, for example, the second user's mobile phone, inbox or computer if the user is online. (Col. 24, Lines 56-65). The invitation message then may be accepted or declined by the second user.

*Kimura* discloses a radio communication apparatus having a rejecting function for informing a calling apparatus of the fact that a received call will not be answered. (Col. 1, Lines 55-58). The apparatus has a first display for detecting the calling apparatus on the receipt of the call, and displaying the identity of the calling apparatus. (Col. 1, Lines 58-60). A second display displays a plurality of answer messages in a rejection mode, and the user of

the called apparatus may select one of the plurality of answer messages displayed on the second display to reject the call. (Col. 1, Lines 61-67).

*Kay* discloses a method and system for interactively responding to requests sent from a user as instant messages. The system includes a message processor 12 which is connected to a data network 14 through an instant messaging (IM) port 16. (Col. 4, Lines 28-34). When message processor 12 receives an IM request from a user 18, the processor 12 forwards the request to a local or remotely located query response server 22. (Col. 4, Lines 58-61). Query response server 22 includes a natural language interpreter or other smart system capable of responding to queries and other request of an arbitrary nature related to topics within at least a specified range of issues by generating an appropriate answer. (Col. 4, Lines 61-66). The answer generated by query response server 22 is returned to the message processor 12, which incorporates the answer into an output message and sends the output message to the user 18 through the IM network. (Col. 4, Line 66 to Col. 5, Line 2). The output message can be forwarded to the user through any other designated means, including e-mail, fax, text messaging to wireless or hand-held devices, voice mail (via a text to speech output system), or any other type of messaging system specified by the user. (Col. 5, Lines 3-7).

**A. There is no Motivation, Teaching or Suggestion to Combine the References**

Applicants respectfully submit that there is no motivation, teaching, or suggestion to combine *Gudjonsson* and *Kimura*, or *Gudjonsson*, *Kay* and *Kimura*, because *Gudjonsson* and *Kimura* teach away from such a combination. Applicants reiterate their argument from the Response to Final Office Action filed on April 13, 2006 because the Examiner has not provided a response to this argument

*Gudjonsson* discloses that in connection with the method and apparatus disclosed therein, a routing service is employed that allows users to send requests (i.e. invitations) for communications sessions to other users, as well as configure how these invitations are handled depending on the user's current presence information. (Col. 3, Lines 9-13). *Gudjonsson* further discloses, "[t]he routing service allows users to send invitations to other users to establish an arbitrary communication session ... over arbitrary networks. *The requests are not sent directly between users.*" (Col. 3, Lines 14-17) (emphasis added). Therefore, "no network addresses need to be exchanged between the users, thus *retaining the anonymity of*

*the users.*” (Col. 3, Lines 29-31) (emphasis added). Hence, utilizing the routing service disclosed by *Gudjonsson*, “a user may establish a communications session with another use without knowledge of the client device (e.g., PC, mobile phone, etc.) being used by the other user.” (Col. 3, Lines 51-54).

On the other hand, *Kimura* discloses an apparatus that has a “first display for detecting the calling apparatus on the receipt of a call, and displaying the [identity of the] calling apparatus.” (Col. 1, Lines 59-61). Hence, while *Gudjonsson* teaches that communication requests are not sent directly between users and that the identity of a communication device is to remain anonymous, *Kimura* contemplates direct communication between user devices in which the identity of user devices does not remain anonymous. Therefore, each of *Gudjonsson* and *Kimura* leads or teaches away from the combination of *Gudjonsson* and *Kimura*, whether or not in further combination with *Kay*. A prior art reference must be considered in its entirety, including portions that would lead or teach away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. § 2141.02(VI). Hence, there is no motivation to combine *Gudjonsson* and *Kimura*, whether or not in further combination with *Kay*.

Furthermore, the proposed combinations are improper because they render the prior art unsatisfactory for their intended purposes and because they would change the principle of operation of a reference. As discussed above, *Gudjonsson* discloses a method and system for establishing communications whereby communication requests are not sent directly between users, and the identity of the communications devices remain anonymous. If *Gudjonsson* were to be combined with *Kimura*, communication requests would be sent directly between users and the identity of communications devices would not remain anonymous. Accordingly, the proposed modification is improper. *See* M.P.E.P. § 2143.01 (V) (“If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”); M.P.E.P. § 2143.01(VI) (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”).

For at least these reasons, Applicants submit that the prior art combinations cannot render obvious Claims 1, 3-6, 9-47, 49-52 and 55-101. As such, Applicants respectfully request that Examiner reconsider, withdraw the rejections under 35 U.S.C. § 103(a) and allow Claims 1, 3-6, 9-47, 49-52 and 55-101. If the Examiner maintains that the combination of *Gudjonsson* and *Kimura*, or *Gudjonsson, Kay* and *Kimura* are proper, Applicants respectfully request that the motivation to combine the references be sufficiently specific and included in a Non-Final Office Action.

**B. The References Fail to Disclose Each and Every Element Recited in the Claims**

Claim 1 recites a method comprising “receiving from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session.”

Claim 33 recites a method comprising “receiving from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session.”

Claim 47 recites a data processor program product, the data processor program being capable of enabling said at least one data processor of a communication apparatus to “receive from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session.”

Claim 79 recites a data processor program product, the data processor program being capable of enabling at least one data processor of a communication apparatus to “receive from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one

response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session.”

Claim 93 recites a communication apparatus including at least one communication session system, the at least one communication system capable of “receiving from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session.”

Applicants respectfully submit that, even assuming, *arguendo*, that the references cited by Examiner may be properly combined, such references cannot render obvious the rejected Claims, because the references fail to disclose, teach, suggest or make obvious each element of the rejected Claims. For example, none of *Gudjonsson*, *Kay* or *Kimura*, whether alone or in combination, disclose, teach, suggest or make obvious a method comprising “receiving from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session,” as recited in amended Claim 1. Specifically, none of the references disclose a reply selected to accept a request for implementing an interactive communication session during a mediated communication session where the reply is selected from at least one response displayed on the second communication device in response to receiving the request for the interactive communication session. (emphasis added)

In the Final Office Action mailed on February 14, 2006, the Examiner argues that “Kimura teaches a second user selecting a reply from at least one response displayed on a second communication device, (col. 1, lines 55-67).” (Final Office Action, Page 3). The cited portion of *Kimura* states:

In accordance with the present invention, a radio communication apparatus *having a rejecting function for informing a calling apparatus of the fact that a received call will not be answered* has a first display for detecting the calling apparatus on the receipt of a call, and displaying the calling apparatus. A storage stores a plurality of answer messages beforehand. *A second display displays the plurality of answer messages in a rejection mode.*

A selecting section allows any one of the plurality of answer messages to be selected on the second display. A transmitter section transmits the message selected via the selecting section to the calling apparatus.

(Col. 1, Lines 55-67) (emphasis added). *Kimura* further discloses that if the user wants to reject an incoming call, “the user operates the reject button 42. (step S108). In response, all the messages stored in the storage 6 are read out (step S109) and displayed on the display 10 (step S11).” (Col. 3, Lines 10-14). *Kimura*, therefore, requires an action by the user (i.e., rejection of an incoming call by pressing a reject button) in order for the messages to be displayed for selection by the user. In contrast, Claim 1, as amended, recites the limitation of “receiving from the second user via the second communication device a reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device, the at least one response displayed on the second communication device in response to receiving the request for implementing the interactive communication session.” (emphasis added). For at least these reasons, the cited references fail to disclose the recited elements, and therefore, cannot render obvious Claim 1. In addition, for analogous reasons, the cited references fail to disclose, teach or suggest all of the limitations recited in Claims 33, 47, 79 and 93.

Given that Claims 3-6 and 9-32 depend from Claim 1, Claims 34-46 depend from Claim 33, Claims 49-52 and 55-78 depend from Claim 47, Claims 80-92 depend from Claim 79, and Claims 94-101 depend from Claim 93, Applicants respectfully submit that Claims 3-5, 9-32, 34-46, 49-52, 55-78, 80-92 and 94-101 are allowable. As such, Applicants respectfully request that the Examiner withdraw the rejections and allow Claims 1, 3-6, 9-47, 49-52 and 55-101.

#### **Request for Continued Examination (RCE)**

Applicants enclose a Request for Continued Examination (RCE) Transmittal, along with a check in the amount of \$790.00 for the RCE fee.

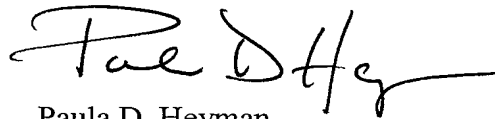
**CONCLUSION**

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for examination and allowance. For the foregoing reasons, Applicants respectfully request reconsideration of the application and allowance of Claims 1-6, 8-12, 21, 22, 31-34 and 40-49, as amended.

Applicants enclose a Petition for Two Month Extension of Time and authorize the Commission to charge the extension fee of \$450.00 and the \$790.00 RCE filing fee to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing. If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,

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Date: November 24, 2006

**SEND CORRESPONDENCE TO:**

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Enclosures: 1) Request for Continued Examination (RCE) Transmittal  
2) Petition for Two Month Extension of Time